

REMARKS

Claims 1-10, 12-38, 43, and 45 are pending in this application.

Applicant has amended claims 1, 12-14, 25-29, 33, 34, 38, and 45. The changes to the claims made herein do not introduce any new matter.

Claim Objections

In response to the objection to claims 1, 12-14, 25-29, 33, 34, and 38, Applicant has amended each of these claims to correct the informalities noted by the Examiner. Accordingly, Applicant requests that the objection to claims 1, 12-14, 25-29, 33, 34, and 38 be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph

Applicant respectfully requests reconsideration of the rejection of claims 12, 28, and 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant notes that each of present claims 12, 28, and 38 defines a computer-readable storage medium *having a computer program stored thereon*. In Paragraph [0037], Applicant's specification describes "a read-only memory (ROM) 242 for non-volatile storage of programs for execution by CPU 241." Further, each of as-filed claims 12, 28, and 38 defines a "computer-executable" program. As such, Applicant submits that the as-filed specification demonstrates that Applicant had possession of the subject matter recited in present claims 12, 28, and 38.

Moreover, it was well known to one having ordinary skill in the art at the time the subject application was filed that a computer-executable program, such as the various programs described in the subject application, could be stored on a computer-readable medium to thereby form a computer program product. Thus, the recitation of the phrase "computer-readable medium" in present claims 12, 28, and 38 does not involve the introduction of prohibited new matter.

In support of the rejection, the Examiner states that the phrase “computer-readable medium” is not “explicitly recited within the specification and therefore brings up a new matter situation.” Final Office Action at page 3. Applicant respectfully submits that the written description requirement does not require that claimed subject matter be “explicitly” described in the specification. Rather, as set forth in M.P.E.P. § 2163:

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”).

For the reasons set forth above, one skilled in the art, upon reading Applicant’s specification, would have understood the inventor to be in possession of the presently claimed subject matter at the time the application was filed. Thus, present claims 12, 28, and 38 comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant requests that the rejection of claims 12, 28, and 38 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejections Under 35 U.S.C. § 103

Applicant respectfully requests reconsideration of the rejection of claims 1-3, 9, 10, 12-16, 22-30, 33-35, 38, 43, and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Ishii et al.* (“*Ishii*”) (US 5,982,416) in view of *Inoue et al.* (“*Inoue*”) (US 6,273,535 B1). As will be explained in more detail below, the combination of *Ishii* in view of *Inoue* would not have rendered the subject matter defined in independent claims 1, 12-14, 25-29, 33, 34, 38, and 45, as amended herein, obvious to one having ordinary skill in the art.

Independent Claims 1 and 12-14

Independent claims 1 and 13 define an image data generating device. Independent claim 12 defines a computer-readable storage medium having a computer program stored thereon, with the computer program causing a computer to perform functions that correspond to the functionality specified in claim 1. Independent claim 14 defines a method for generating image data that includes method steps that correspond to the functionality specified in claim 1. Each of claims 1 and 12-14 has been amended to clarify that what is controlled by the output control data is not the output conditions but rather the image processing to be carried out on the image data by an output device. As will be explained in more detail below, neither the *Ishii* reference nor the *Inoue* reference discloses or suggests the technical concept of allowing an image data generating device to generate output control data for controlling the image processing to be carried out by an output device.

Applicant respectfully submits that the obviousness rejection is flawed because host computer 10 shown by *Ishii* does not transmit an image file containing output control data and image data to printer 22. In particular, the intended receiver of the image file containing output control data and image data is an image processing device, and it is meaningless to transmit the image file to a printer or a monitor which are configured only to print or display the image data.

In the configuration shown by *Ishii*, host computer 10 apparently carries out the image processing. As such, an image file containing output control data and image data should be transmitted from image pickup unit 11 to host computer 10. However, image pickup unit 11 transmits only image data to host computer 10, and the image pickup unit does not transmit any output control data.

Irrespective of how the *Ishii* reference is characterized relative to the claimed subject matter, the *Ishii* reference fails to disclose or suggest an image generating device as defined in present claim 1. To cure the deficiency of the *Ishii* reference regarding the “image data output mechanism” recited in present claim 1, the Examiner combines the *Inoue* reference with the *Ishii* reference.

The configuration shown by *Inoue* stores printing control information in a printer, and a digital still camera (DSC) only transmits image additional information representing image sensing conditions to the printer. This configuration enables the printer to select appropriate printing control information with respect to the image additional information, and the DSC is incapable of controlling the selection made by the printer.

Further, *Ishii*'s configuration allows host computer 10 to have profile information, and the profile information is never provided by image pickup unit 11. Thus, even if *Ishii* were to be taken in combination with *Inoue*, the image processing to be performed would still be *directed by the image processing device*.

In support of the obviousness rejection, the Examiner refers to Figures 7 and 12 (and the corresponding description in column 5) of *Inoue*. At column 4, lines 6-18, however, *Inoue* states that image additional information 11 represents the input states of individual images and parameters of color processing executed in the DSC. *Inoue*'s configuration then obtains information for printing control from the DSC and compares the obtained information with the printer unique state and condition, so as to select the best or most suitable printing control processing (see column 4, lines 56-64).

Further, *Inoue* discloses only a one-on-one connecting state between the DSC and the printer, and does not suggest the technical concept of providing an image processing device with different output control data for multiple different output devices.

As such, the *Inoue* reference fails to disclose or suggest the technical concept of enabling an image data generating device to control the different output modes of an image processing device depending upon multiple output devices as well as the constituent features necessary for realizing the output modes.

Still further, the examples of signals shown in drawings such as, for example, Figure 16 of *Ishii*, are the signals transmitted from the image pickup unit to host computer 10, and the host computer merely outputs processed image data to be output to a printer and a monitor. In other words, *Ishii* discloses and suggests only a technique used in a host, i.e., an image processing device.

The Examiner states that the *Ishii* reference discloses an embodiment that outputs image data with a color profile related thereto to multiple output devices (such as a printer and a monitor), while *Inoue* only describes an embodiment that outputs image data to a single printer. Applicant respectfully submits that this argument is not reasonable because it is not supported by *Ishii*'s disclosure.

In response to the Examiner's assertion that the claimed feature that the output devices are separated from the image data generating device is merely a matter of engineering design choice, Applicant notes that the claimed subject matter is intended to solve problems unique to the case where an image data generating device and an image processing device are separate bodies. The *Ishii* reference provides no suggestion regarding the problems addressed by the claimed subject matter. Consequently, *Ishii*, as the primary reference, does not face the problems arising in the present case, and does not satisfy the claimed features, even if taken in combination with the other references applied in the Office Action.

Accordingly, present claims 1 and 12-14 are patentable under 35 U.S.C. § 103(a) over the combination of *Ishii* in view of *Inoue*.

Independent Claims 25-28

Independent claims 25 and 26 define an image data generating device. Independent claim 27 defines a method for generating image data that includes method steps that correspond to the functionality specified in claim 25. Independent claim 28 defines a computer-readable storage medium having a computer program stored thereon, with the computer program causing a computer to perform functions that correspond to the functionality specified in claim 25. Each of claims 25-28 has been amended to clarify that what is controlled by the output control data is not the output conditions but rather the image processing to be carried out on the image data by an output device.

Claims 25-28 are similar to claims 1 and 12-14, but differ in that they specify the use of identifying information for identifying respective output devices. As such, the arguments set forth above regarding claims 1 and 12-14 also apply to claims 25-28.

Independent Claim 45

Claim 45 defines an image generating device that is similar to that defined in claim 1, but differs in that the claimed configuration is directed toward a single output device. Claim 45 has been amended to clarify that what is controlled by the output control data is not the output conditions but rather the image processing to be carried out on the image data by an output device. The arguments set forth above regarding claim 1 also apply to claim 45.

Independent Claims 29, 33, 34, and 38

Independent claims 29 and 33 define an output control device. Independent claim 34 defines a method for outputting image data that includes method steps that correspond to the functionality specified in claim 29. Independent claim 38 defines a computer-readable storage medium having a computer program stored thereon, with the computer program causing a computer to perform functions that correspond to the functionality specified in claim 29. Each of claims 29, 33, 34, and 38 has been amended to clarify that what is

controlled by the output control data is not the output conditions but rather the image processing to be carried out on the image data by an output device.

The claimed configuration allows the output devices, acting as a slave, to carry out output control processing in accordance with the image processing conditions to be carried out by each of the output devices, as specified by the image data generating device. Even if the *Ishii* and *Inoue* references were to be combined in the manner proposed by the Examiner, the result would not have been the presently claimed subject matter. Accordingly, claims 29, 33, 34, and 38 are patentable under 35 U.S.C. § 103(a) over the combination of *Ishii* in view of *Inoue*.

Claims 2, 3, 9, 10, 15, 16, 22-24, 30, 35, and 43

Each of claims 2, 3, 9, 10, and 43 depends from claim 1. Each of claims 15, 16, and 22-24 depends from claim 14. Claim 30 depends from claim 29, and claim 35 depends from claim 34. Thus, claims 2, 3, 9, 10, 15, 16, 22-24, 30, 35, and 43 are patentable under 35 U.S.C. § 103(a) over the combination of *Ishii* in view of *Inoue* for at least the reason that each of these claims depends from one of claims 1, 14, 29, and 34.

Applicant respectfully requests reconsideration of the rejection of claims 4-8, 17-21, 31, 32, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Ishii* in view of *Inoue*, and further in view of *Kohler et al.* ("*Kohler*") (US 5,646,752). Each of the claims 4-8, 17-21, 31, 32, 36, and 37 ultimately depends from one of independent claims 1, 14, 29, and 34. The *Kohler* reference does not cure the above-discussed deficiencies of the combination of the *Ishii* and *Inoue* references relative to the claimed subject matter, as presently defined in the independent claims. Accordingly, claims 4-8, 17-21, 31, 32, 36, and 37 are patentable under 35 U.S.C. § 103(a) over the combination of *Ishii* in view of *Inoue* and *Kohler* for at least the reason that they ultimately depend from one of independent claims 1, 14, 29, and 34.

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Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1-10, 12-38, 43, and 45, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP003).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read 'P. B. Martine', with a long horizontal flourish extending to the right.

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